

RECEIVED  
CENTRAL FAX CENTER

JUL 31 2008

REMARKS

In the Final Office Action mailed on June 13, 2008, claims 1-6, 8-19, 27-32 and 34-38 were pending and stand finally rejected. Reconsideration of and withdrawal of the final rejection of the claims in the present application in view of the following remarks is respectfully requested.

Claims 27-32, 34, and 35 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,505,732 to Michelson alone. Claim 27 recites the surgical instrument includes the following elements: 1) a shaft with an engaging portion at a distal end of the shaft and the engaging portion has an enlarged configuration extending outwardly from the shaft; 2) a distractor tip that extends distally from the enlarged engaging portion; 3) a member that is a guide sleeve housing with a proximal portion defining a chamber and a distal portion defining first and second access ports; and 4) the enlarged configuration of the engaging portion at the distal end of the shaft is sized and shaped to fit in the proximal chamber of the guide sleeve housing with a close interfit to provide a rigid assembly between the engaging portion and the guide sleeve housing.

The Final Office Action asserts tubular portions 348 in Fig. 7F are a shaft, some portion of Fig. 7F near footplate 344 is an engaging portion at the distal end tubular portions 348, and that footplate 344 is a guide sleeve housing with a proximal and distal chamber. See page 5, lines 9-18. The Final Office Action also asserts that the engaging portion of tubular portions 348 near footplate 344 include an enlarged configuration that extends outwardly from tubular portions 348 and the distal tip 102. The examiner has not identified any structure in Michelson that teaches or suggests an engaging portion at the distal end of tubular portions 348 having an enlarged configuration that extends outwardly from both tubular portions 348 and distractor tip 102. If footplate 344 is considered the engaging portion with the enlarged configuration, then it cannot be properly considered to correspond to the guide sleeve housing of claim 27 since claim 27 makes clear "said enlarged configuration being sized and shaped to fit in said proximal chamber" of the guide sleeve housing. Footplate 344 cannot be both the engaging portion with the enlarged configuration and also the guide sleeve housing with the proximal chamber since it is not possible for footplate 344 to both define a chamber and also be sized and shaped to fit in the chamber in which it defines. Therefore, the rejection of claim 27 is intrinsically flawed since

---

Response to Final Office Action  
Serial No. 10/689,277  
Attorney Docket No. MSDI-269/PC545.02  
Page 2 of 6

the cited reference does not disclose or suggest all the elements arranged in the manner recited in claim 27.

In responding to applicants' arguments submitted in the response filed February 28, 2008, the examiner responds by noting that the portion with the enlarged configuration, presumably tubular portions 348, once separated from the device, presumably footplate 344, would be capable of being wedged or forced into at least a portion of the proximal chamber to create such a fit. As discussed above, in Fig. 7F the Examiner has failed to identify any portion of tubular portions 348 near footplate 344 that is enlarged to extend outwardly from tubular portions 348 that is also sized and shaped to fit in a proximal chamber of the footplate 344 as is defined for the engaging portion in claim 27. It is respectfully submitted that "[a]ll words in a claim must be considered in judging the patentability of the plate against the prior art." In re Wilson, 165 USPQ 494, 496 (CCPA 1970), MPEP 2143.03.

The examiner also asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have separated what can be considered to be the guide sleeve assembly (namely ref. 344) from the guide sleeve, ref. 348) (sic), since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179." It is respectfully submitted that there is no *per se* rule for obviousness. In re Ochiai, 37 USPQ 2d 1127, 1133 (Fed. Cir. 1995). The Office Action fails to explain or cite any prior art teaching that would have fairly suggested, to one of ordinary skill in the art, the desirability of making tubular portions 348 releasably engageable from footplate 344. While the examiner notes that Michelson teaches connection mechanisms at col. 2, lines 6-11, as explained previously, the cited portion of Michelson is discussing techniques for securing collar 248 to drill 240 in a lockably adjustable manner. The Examiner has pointed to no teaching that such mechanisms are employed to secure tubular portions 348 to footplate 344, or any teaching or suggestion of how such a connection arrangement could be configured with tubular portions 348 and footplate 344 to arrive at the invention recited in claims 31 and 32.

Furthermore, the examiner appears to equate "a flange and groove" disclosed in Michelson for lockably adjusting a drill to a sleeve to the finger and receptacle of claim 31. Claim 31 states the finger and receptacle are part of the engaging portion at the distal end of the

shaft and the finger is movable out of the receptacle to engage the guide sleeve housing and movable into the receptacle to release the guide sleeve housing. The Examiner has failed to explain, nor is it not understood how one of ordinary skill in the art would have any reason to modify tubular portion 348 to include "a receptacle formed therein and a finger movable out of said receptacle to an engagement position wherein said finger engages said guide sleeve housing in said proximal chamber and wherein said finger is movable to a release position into said receptacle to release said guide sleeve housing from said engaging portion" based on Michelson's disclosure of lockably adjusting a drill to a sleeve with "flanges engaging grooves forced therein by either a cap pulled over the flanges or screwed down upon them".

In addition, it is respectfully submitted functional limitations that define an interrelationship between structural elements of the claim may not be properly ignored. MPEP §2173.05(g) states "[a] functional limitation must be evaluated and considered, just like any other limitation in the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." The MPEP goes on to further to refer to In re Venezia, 189 USPQ 149 (C.C.P.A. 1974) and recites "[i]n a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be positioned' and 'portions ... being resiliently dilatable whereby said housing may be slidably positioned' serve to precisely define structural attributes of interrelated component parts of the claimed assembly." With regard to claims 31 and 32, it is clear that the structural attributes of the claimed component parts and interrelation as defined by the functional limitations have not been considered. For at least these reasons, withdrawal of the rejection of claims 28-32 and 34-35 depending from claim 27 is respectfully requested.

Claims 1-6, 8-19 and 36-38 were rejected under 35 USC §103(a) as unpatentable over Michelson in view of U.S. Patent No. 5,055,104 to Ray. The Final Office Action responds to applicants' previous arguments with respect to the distractor in the cited references not being located in a location between the ports by asserting that this is a functional clause and the device must merely be capable of performing such a function. It is respectfully submitted that the Examiner has failed to point out how the cited references are even capable of functioning as claimed. Michelson discloses tubular portions 348 that form separate ports that each have a wall extending therearound, with the walls separated by an area 350 at a location between the ports.

---

Response to Final Office Action  
Serial No. 10/689,277  
Attorney Docket No. MSDI-269/PC545.02  
Page 4 of 6

See col. 28, lines 8-12. Footplate 344 includes a wall at a location between each of the ports extending therethrough. See Fig. 7C. In maintaining the final rejection, the examiner asserts that since the distractor tips are located between the lateral most portions of the ports the distractor tips 102 can be considered to be located between the ports. However, even if the distractor tips are between the lateral most portions of the ports of tubular portions 348, neither is “movably positionable from a location between said first and second working channel ports...” as recited in claim 1. Claim 1 specifies the location of the distractor is between the ports, and any location entirely within one port or the other port is not between the ports, but rather is a location within the port. In order support the rejection, it appears the examiner is ignoring the limitations that specify the location is between the ports, and improperly broadening the limitation to construe that the location is between lateral most portions of the ports in order to support the rejection. Michelson discloses distractors within one port and/or the other port, but not in a location between the ports since the walls of tubular portions 348 and footplate 344 occupy that space. Since distractor tips 102 are not capable of being movably positionable from area 350 between tubular portions 348 or through the central wall of footplate 344, and since Ray does not address these deficiencies, it is respectfully submitted that a prima facie case for rejecting claim 1 has not been established and withdrawal of the rejection of claim 1 is respectfully requested.

Claim 36 recites, among other features, “said central distractor including a distractor tip at a location between said first and second working channel ports”. As an initial matter, it is clear that this is not a functional clause since it positively recites the location of the distractor tip relative to the working channel ports. Second, as discussed above with respect to claim 1, this arrangement of elements is not disclosed or suggested in the cited references. Therefore, withdrawal of the rejection of claim 36 is respectfully requested.

The Office Action also fails to provide a prima facie case for rejecting claims depending from claims 1 and 36. For example, claims 9 and 10 are allowable for reasons provided above with respect to claims 31 and 32. Claims 3, 8 and 11 are allowable for reasons provided in the previous response. Accordingly, claims 2-6 and 8-19 depending from claim 1 and claims 37-38 depending from claim 36 are allowable at least for the reasons the claim from which each depends is allowable. Withdrawal of the rejection of these claims is respectfully requested.

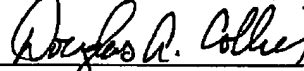
---

Response to Final Office Action  
Serial No. 10/689,277  
Attorney Docket No. MSDI-269/PC545.02  
Page 5 of 6

JUL 31 2008

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance with pending claims 1-6, 8-19, 27-32 and 34-38. Reconsideration of the present application as amended is respectfully requested. Timely action towards a Notice of Allowance is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted,



Douglas A. Collier, Reg. No. 43,556  
Krieg DeVault LLP  
One Indiana Square, Suite 2800  
Indianapolis, IN 46204  
Phone: (317) 238-6333 (direct)

Response to Final Office Action  
Serial No. 10/689,277  
Attorney Docket No. MSDI-269/PC545.02  
Page 6 of 6